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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARDENAS NAVIA, JAIME F

ART UNIT

PAPER NUMBER

3624

NOTIFICATION DATE

DELIVERY MODE

06/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@verizon.com

Office Action Summary	Application No. 10/721,471	Applicant(s) TOR ET AL.	
	Examiner Jaime Cardenas-Navia	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. This **NON-FINAL** office action is in response to communications received on May 4, 2010. Claims 1, 4-7, 13,18, and 19 have been amended. Claim 20 has been cancelled. Claim 19 has been added. Claims 1-19 and 21 are currently pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2010 has been entered.

Response to Amendment

3. **New grounds of objection to the claims** are necessitated by amendment.
4. **New grounds of rejection under 35 U.S.C. § 112, second paragraph**, are necessitated by amendment.
5. **New grounds of 35 U.S.C. § 101 rejections** are necessitated by amendment.

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Claim Objections

6. **Claim 1 is objected to** because of the following informalities: in the 'means for receiving registration information' clause, "from said each of said" should be amended to "from each of said". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-17 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 7, and 13, in the 'means for receiving a visitation request' clause (and equivalents), "said visitors" lacks antecedent basis. It should be amended to "said potential visitors."

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 7-19 and 21 are rejected** under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

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Regarding claims 7, 18, and 21, based on Supreme Court precedent (See *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978)) and recent Federal Circuit decisions (See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (2008)), a method claim must have a specialized, limited meaning to qualify as a patent-eligible process claim. This is embodied in the "machine or transformation test", which states that a § 101 process must (1) be tied to a particular machine or apparatus or (2) transform a particular article to a different state or thing.

More specifically, the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Thus, a field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. Additionally, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. Thus, reciting a specific machine or a particular transformation in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Independent claims 7, 18, and 21 contain steps that are not necessarily tied to a particular machine or apparatus and are therefore directed to non-statutory subject matter. Examiner notes that for process claims implemented on a computer to be considered statutory, they must make clear which steps are executed on the computer and which steps are executed manually.

Examiner does not believe it has been made sufficiently clear that the steps are performed on a computer, rather than merely implemented with the aid of a computer. For purposes of examination, Examiner has assumed that necessary corrections have been made.

Regarding claim 13, the claimed 'computer program product including computer-readable program code' could include signals. Signals and waves are considered non-statutory subject matter. To overcome this rejection, Examiner recommends amending the claims to

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explicitly state that the computer program product does not transmit (propagate) signals. This will not be considered new matter.

For purposes of examination, Examiner has assumed that necessary corrections have been made.

Response to Arguments

11. Applicant's arguments have been fully considered by the Examiner. In particular, Applicant argues that:

(A) regarding independent claims 1, 7, 13, 18, and 21, none of the cited references or officially noticed facts teach or suggest determining via a prison interface if the inmate has visitation privileges; and

(B) all dependent claims are allowable based on their dependency.

Regarding argument (A) and (B), they are moot in view of the new grounds of rejection presented below.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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13. **Claims 1-19 and 21 are rejected** under 35 U.S.C. 102 (e) as being anticipated by Hesse (US 7,046,779 B2).

Regarding claim 1, Hesse teaches an inmate visitation system (abstract), comprising:

means for determining via a prison interface if an inmate has visitation privileges (col. 7, lines 30-42, limit participation to qualified participants, col. 9, lines 7-33, TABLE 1, permitted type of visit, privileges and changes in visiting privileges);

means for receiving a visitation request only from an inmate having said visitation privileges for a plurality of potential visitors to attend the same visitation, each of said potential visitors being named in said request by said privileged inmate (col. 7, lines 30-42, limit participation to qualified participants, conferences, registration, col. 9, lines 7-33, Table 1, permitted type of visit, privileges and changes in visiting privileges);

means for sending a registration request to each of the plurality of potential visitors based upon the received visitation request (col. 7, lines 30-42, limit participation to qualified participants, conferences, registration, col. 4, lines 15-27, registration of users, col. 9, Table 1);

means for receiving registration information from each of said plurality of potential visitors based upon the sent registration request (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2);

means, responsive to operation of said registration information receiving means, for determining whether the visitation request from the privileged inmate is approved or disapproved (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors);

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means for communicating the approval or disapproval of the visitation request (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors, col. 7, lines 56-67, col. 8, lines 1-16, notification); and

means, operative in response to said registration receiving means, for permitting one of said plurality of said potential visitors to schedule said same visitation for all of said plurality of potential visitors if said visitation request is approved (fig. 10, scheduling system).

Regarding claim 2, Hesse teaches means for recording information associated with one or more of the visitation request, the registration request and the visitation approval or disapproval (Table 1, Table 2).

Regarding claim 3, Hesse teaches wherein the means for determining is at least one of a prison official and an analytical process that reviews at least one of historical visitation requests and visitation data (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors).

Regarding claim 4, Hesse teaches wherein the means for recording further maintains a history of potential visitors including the plurality of potential visitors requested by the privileged inmate (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors).

Regarding claim 5, Hesse teaches wherein the visitation request includes at least one of a name (par. 124), address, telephone number and relationship to the privileged inmate of at least one of the plurality of potential visitors (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors).

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Regarding claim 6, Hesse teaches means for scheduling, for approved ones of the potential visitors, an available time to visit the inmate (fig. 10, scheduling process).

Regarding claims 7-12, they are rejected using the same art and rationale used above for rejecting claims 1-6. This is because claims 7-12 claim a method performing the steps carried out by the system of claims 1-6.

Regarding claim 13, Hesse teaches a computer program product including computer-readable program code for use in a computer, said computer-readable program code comprising:

visitation registration program code executable on said computer only for visitation requests made via a prison interface by inmates having visitation privileges (col. 7, lines 30-42, limit participation to qualified participants, col. 9, lines 7-33, TABLE 1, permitted type of visit, privileges and changes in visiting privileges), said visitation registration program code for

receiving a visitation request from a privileged inmate for a plurality of potential visitors to attend the same visitation, each of said potential visitors being named in said request by said inmate (col. 7, lines 30-42, limit participation to qualified participants, conferences, registration, col. 9, lines 7-33, Table 1, permitted type of visit, privileges and changes in visiting privileges);

automatically approving or disapproving a registration request for each of the plurality of potential visitors, the registration request sent to each of the plurality of potential visitors based upon the visitation request (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors);

recording information associated with at least one of the visitation request and the registration request (table 1, table 2); and

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visitation scheduling program code for permitting an approved one of said plurality of potential visitors to schedule an available time for all approved ones of said plurality of potential visitors to visit said inmate at said same visitation (fig. 10, scheduling).

Regarding claim 14, Hesse teaches wherein the visitation scheduling program code is accessed by an approved potential visitor.

Williams teaches wherein the visitation scheduling program code is accessed by an approved potential visitor (fig. 10).

Regarding claim 15, Hesse teaches wherein the visitation registration program code further comprises communicating disapproval of the registration request in response to the registration request (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors).

Regarding claim 16, Hesse teaches wherein the visitation registration program code further allows the plurality of potential visitors to access a status of the registration request (col. 8, lines 17-33, status of participant, Table 1, Table 2).

Regarding claim 17, Lue Chee Lip teaches wherein if additional information is needed the visitation registration program code further places the registration request on hold pending the additional information (Table 5, placed on hold while waiting to be scheduled or if denied).

Regarding claim 18, Hesse teaches an automated method to register and schedule a plurality of potential visitors in a given timeslot for a visit with an inmate (abstract), the method comprising:

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determining, via a prison interface, if the inmate has visitation privileges (col. 7, lines 30-42, limit participation to qualified participants, col. 9, lines 7-33, TABLE 1, permitted type of visit, privileges and changes in visiting privileges);

receiving names of the plurality of potential visitors from a privileged inmate along with a request to provide registration information of all said potential visitors in order to schedule the visit with the privileged inmate (col. 7, lines 30-42, limit participation to qualified participants, conferences, registration, col. 9, lines 7-33, Table 1, permitted type of visit, privileges and changes in visiting privileges);

forwarding said request to each of the plurality of potential visitors (col. 7, lines 30-42, limit participation to qualified participants, conferences, registration, col. 4, lines 15-27, registration of users, col. 9, Table 1);

said each potential visitor supplying its own requested registration information to a sender of the request (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors);

receiving an approval notification for at least one of the plurality of potential visitors to attend said visit (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors);

one of said at least one of the plurality of potential visitors accessing a visitation schedule to enter a proposed visiting time corresponding to the given timeslot to schedule the visit for all said at least one of the plurality of potential visitors with the privileged inmate (fig. 10, scheduling process);

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determining whether the privileged inmate is available at the proposed visiting time (fig. 10, col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors); and

if the privileged inmate is available during the proposed visiting time, receiving a schedule and confirmation number (fig. 10, notice, col. 7, lines 56-56, col. 8, lines 1-16, notification).

Regarding claim 19, Hesse teaches wherein the request is based upon a visitation request supplied by the privileged inmate (fig. 10, col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors).

Regarding claim 21, Hesse teaches a computer implemented process comprising:

(a) determining, via a prison interface, if said inmate has visitation privileges (col. 7, lines 30-42, limit participation to qualified participants, col. 9, lines 7-33, TABLE 1, permitted type of visit, privileges and changes in visiting privileges) and, only if so, continuing with steps (b) through (g);

(b) said privileged inmate providing names and contact information of a plurality of potential visitors to an inmate-visitation, said names and contact information being provided as an input to a computer, thereby obtaining a visitation request (fig. 10, col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2,);

(c) sending, by operation of said computer, a registration request to each of said named potential visitors to obtain information about said each of said named potential visitors (col. 7, lines 30-42, limit participation to qualified participants, conferences, registration, col. 4, lines 15-27, registration of users, col. 9, Table 1);

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(d) said each of said named potential visitors responding to said registration request, by operation of said computer, by providing said information about itself (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors);

(e) at least one of said named potential visitors receiving, by operation of said computer, a registration number uniquely identifying said at least one of said named potential visitors (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors);

(f) one of said at least one of said named potential visitors proposing, by operation of said computer, a date and time for said inmate-visitation for each of said named potential visitors who received a registration number (fig. 10, col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors); and

(g) deciding if any of said named potential visitors who received a registration number shall be disallowed to attend said visitation and communicating, by operation of said computer, said decision to all said named potential visitors having registration numbers (col. 4, lines 15-27, col. 7, lines 30-42, col. 9, Table 1, col. 14 and 15, Table 2, business rules governing visitation privileges for prisoners and visitors).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Profanchik et al. (US 7,256,816 B2) teaches a system and method for scheduling and conducting audio/video communications with prison inmates.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime Cardenas-Navia whose telephone number is (571)270-1525. The examiner can normally be reached on Mon-Fri, 10:30AM - 7:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./

Examiner, Art Unit 3624

June 14, 2010

/Romain Jeanty/

Primary Examiner, Art Unit 3624